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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/763,884

01/23/2004

Rami Caspi

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6012

7590

07/28/2005

Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,884

Applicant(s)

CASPI ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/04, 4/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure

1. The information disclosure statement submitted on January 23, 2004 and April 21, 2005 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claim(s) 1, 4-6, 10-15, 17 and 18** are rejected under 35 U.S.C. 102(e) as being anticipated by Adamczyk (US 2004/0151284 A1).

Regarding **claim(s) 1**, Adamczyk discloses a method (FIG. 2 and paragraph 0002), comprising:

receiving a first voice mail message, said first voice mail message being associated with a recipient (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

converting said first voice mail message to a first instant message (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform];

determining an instant message address associated with said recipient (FIG. 2 and paragraph 0067) [The VMS 306 retrieves a corresponding address for an instant message user from an associated database]; and

sending said first instant message to said address (FIG. 2 and paragraph 0071) [The VMS 306 sends the instant message to the instant message platform corresponding to the recipient address].

Regarding **claim(s) 4**, Adamczyk discloses a method, further comprising:

receiving a command from said recipient regarding said first voice mail message (FIG. 4 and paragraph 0075) [The recipient as the option to send a reply to the message and upon receive the command of the recipient the interface 336 sends an indication from the recipient].

Regarding **claim(s) 5**, Adamczyk discloses a method, further comprising:

receiving a command from said recipient regarding a second voice mail message (FIG. 4 and paragraph 0075) [For each message received, the recipient as the option to send a notification back to the originated subscriber and upon receive the command of the recipient the interface 336 generates a notification from the recipient].

Regarding **claim(s) 6**, Adamczyk discloses a method, further comprising:
sending data indicative of a calling telephone number associated with said first voice mail message (FIG. 4 and paragraph 0077) [The indication is associated with information of the originated subscriber such as a telephone number].

Regarding **claim(s) 10**, Adamczyk discloses a method, further comprising:
receiving a second instant message, said second instant message being indicative of a request for information regarding at least one voice mail message associated with said recipient (FIG. 4 and paragraph 0077) [The notification to the originating subscriber can reference the voice message sent by the VMS 306, 316].

Regarding **claim(s) 11**, Adamczyk discloses a method, further comprising:
receiving a second instant message, said second instant message including a text message (FIG. 4 and paragraph 0078) [The notification to the originating subscriber can be sent via an instant message platform as a text message].

Regarding **claim(s) 12**, Adamczyk discloses a method, further comprising:
converting said second instant message into a second voice mail message (FIG. 4 and paragraph 0078) [The notification to the originating subscriber can be sent by the VMS 306, 316 via a voice mail message, thereby converting said second instant message into a second voice mail message].

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Regarding **claim(s) 13**, Adamczyk discloses a method, further comprising:

providing said second voice mail message to a party associated with said first voice mail message (FIG. 4 and paragraph 0078) [The notification to the originating subscriber can be sent by the VMS 306, 316 via a voice mail message, thereby providing said second voice mail message to a party associated with said first voice mail message].

Regarding **claim(s) 14**, Adamczyk discloses a method, wherein said second instant message includes data indicative of a party and further comprising providing said second voice mail message to said party (FIG. 4 and paragraphs 0077-0078) [The notification to the originating subscriber includes information about the originating subscriber and can be sent by the VMS 306, 316 via a voice mail message, thereby said second instant message includes data indicative of a party and further comprising providing said second voice mail message to said party].

Regarding **claim(s) 15**, Adamczyk discloses a method (FIG. 2 and paragraph 0002), comprising:

receiving a voice mail message, said voice mail message being associated with a recipient (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

converting the voice mail message into a text file (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform];

determining an instant message address associated with said recipient (FIG. 2 and paragraph 0067) [The VMS 306 retrieves a corresponding address for an instant message user from an associated database]; and

providing said text file and said address to an instant message system (FIG. 2 and paragraph 0071) [The VMS 306 sends the instant message to the instant message platform corresponding to the recipient address].

Regarding **claim(s) 17**, Adamczyk discloses an article of manufacture (FIG. 2 and paragraph 0002) comprising:

a computer readable medium having stored thereon instructions which, when executed by a processor (FIG. 2 and paragraph 0053) [The VMS 306, 316 includes a processor runs by software to executed multiple task such as a hard drive storing all the instructions], cause said processor to:

receive a first voice mail message, said first voice mail message being associated with a recipient (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

convert said first voice mail message to an instant message (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform];

determine an instant message address associated with said recipient (FIG. 2 and paragraph 0067) [The VMS 306 retrieves a corresponding address for an instant message user from an associated database]; and

send said instant message to said address (FIG. 2 and paragraph 0071) [The VMS 306 sends the instant message to the instant message platform corresponding to the recipient address].

Regarding **claim(s) 18**, Adamczyk discloses an apparatus (FIG. 2 and paragraph 0002), comprising:

a processor (Processor 306b on FIG. 2);

a communication port (User Interface 306a on FIG. 2) coupled to said processor and adapted to communicate with at least one device (FIG. 2 and paragraph 0051) [The VMS 306 includes a user interface adapted to receive a voice message from a sending subscriber]; and

a storage device (hard drive of the computer based platform VMS 306 on FIG. 2) coupled to said processor and storing instructions adapted to be executed by said processor (FIG. 2 and paragraph 0053) [The VMS 306, 316 includes a processor runs by software to executed multiple task such as a hard drive storing all the instructions] to:

receive a first voice mail message, said first voice mail message being associated with a recipient (FIG. 2 and paragraph 0066) [The VMS 306, 316 receives a message from a sending subscriber for a recipient subscriber];

convert said first voice mail message to an instant message (FIG. 2 and paragraph 0069) [The voice mail message is encoded into a text message suitable for transmission at an instant message platform];

determine an instant message address associated with said recipient (FIG. 2 and paragraph 0067) [The VMS 306 retrieves a corresponding address for an instant message user from an associated database]; and

send said instant message to said address (FIG. 2 and paragraph 0071) [The VMS 306 sends the instant message to the instant message platform corresponding to the recipient address].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claim(s) 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Hanson et al. (US 6,697,474 B1).

Regarding **claim(s) 2**, Adamczyk as applied to **claim(s) 1** above differs from **claim(s) 2**, in that it fails to disclose determining if said recipient is available to receive an instant message.

However, Hanson, in the same field of endeavor, teaches a method, further comprising:

determining if said recipient is available to receive an instant message (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the automated call processor as taught by Hanson.

This modification of the invention enables the system to determine if said recipient is available to receive an instant message so that the user would receive a telephone call via its instant messaging client as a virtual second telephone line (Hanson: column 2, lines 1-6).

Regarding **claim(s) 3**, Adamczyk as applied to **claim(s) 1** above differs from **claim(s) 3**, in that it fails to disclose wherein said sending said first instant message to said address occurs only after determining that said recipient is available to receive an instant message.

However, Hanson, in the same field of endeavor, teaches, wherein said sending said first instant message to said address occurs only after determining that said recipient is available to receive an instant message (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line to send the voice mail as an instant message].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the automated call processor as taught by Hanson.

This modification of the invention enables the system to send said first instant message to said address occurs only after determining that said recipient is available to receive an instant message so that the user would receive a telephone call via its instant messaging client as a virtual second telephone line (Hanson: column 2, lines 1-6).

8. **Claim(s) 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Agraharam et al. (US 6,654,448 B1).

Regarding **claim(s) 7**, Adamczyk as applied to **claim(s) 1** above differs from **claim(s) 7**, in that it fails to disclose sending data indicative of said first voice mail message's length of time.

However, Agraharam, in the same field of endeavor, teaches a method, further comprising:

sending data indicative of said first voice mail message's length of time (FIG. 1 and column 6, lines 23-36) [The information is data that indicates the time required for transmitting the message].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the network as taught by Agraharam.

This modification of the invention enables the system to send data indicative of said first voice mail message's length of time so that the system would charge the user for each message transmitted (Agraharam: column 6, lines 37-44).

Regarding **claim(s) 8**, Adamczyk as applied to **claim(s) 1** above differs from **claim(s) 8**, in that it fails to disclose sending data indicative of a number of voice mail messages associated with said recipient.

However, Agraharam, in the same field of endeavor, teaches a method, further comprising:

sending data indicative of a number of voice mail messages associated with said recipient (FIG. 1 and column 5, lines 23-36) [The information is data that indicates the cumulative number of documents transmitted].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the network as taught by Agraharam.

This modification of the invention enables the system to send data indicative of a number of voice mail messages associated with said recipient so that the system would charge the user for each message transmitted (Agraharam: column 6, lines 37-44).

9. **Claim(s) 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk in view of Groner (US 6,507,643 B1).

Regarding **claim(s) 9**, Adamczyk as applied to **claim(s) 1** above differs from **claim(s) 9**, in that it fails to disclose converting said first voice mail message to an email message, determining an email address associated with said recipient and sending said email message to said email address.

However, Groner, in the same field of endeavor, teaches a method, further comprising:

converting said first voice mail message to an email message (FIG. 2 and column 4, line 65 to column 5 line 1) [The voice-to-electronic mail system 30 generates a text message file from the audio message from the caller, thereby converting the voice mail message to an email message];

determining an email address associated with said recipient (FIG. 2 and column 4, lines 62-65) [The voice-to-electronic mail system 30 determines an e-mail address in accordance with the recipient' s telephone number]; and

sending said email message to said email address (FIG. 2 and column 5, lines 2-4) [The voice-to-electronic mail system 30 sends a text message file at the recipient' s e-mail address].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Adamczyk using the voice-to-electronic mail system as taught by Groner.

This modification of the invention enables the system to convert said first voice mail message to an email message, determining an email address associated with said recipient and sending said email message to said email address so that the system would reduce the amount of data that is transmitted (Groner: column 3, lines 41-43).

10. **Claim(s) 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Groner in view of Hanson.

Regarding **claim(s) 16**, Groner discloses a method (FIG. 2 and column 4, lines 56-58), comprising:

receiving a voice mail message, said voice mail message being associated with a recipient (FIG. 2 and column 4, lines 58-62) [The voice-to-electronic mail system 30 receives a voice message from the caller for the recipient];

converting the voice mail message to an email message (FIG. 2 and column 4, line 65 to column 5 line 1) [The voice-to-electronic mail system 30 generates a text message file from the audio message from the caller, thereby converting the voice mail message to an email message];

determining an email address associated with said recipient (FIG. 2 and column 4, lines 62-65) [The voice-to-electronic mail system 30 determines an e-mail address in accordance with the recipient's telephone number]; and

sending said instant message to said email address (FIG. 2 and column 5, lines 2-4) [The voice-to-electronic mail system 30 sends a text message file at the recipient's e-mail address].

Although, Groner discloses the voice mail message converted to a text message for e-mail but fails to disclose determining if said recipient is available to receive an instant message and converting the voice mail message to an email message if said recipient is not available to receive an instant message.

However, Hanson, in the same field of endeavor, teaches determining if said recipient is available to receive an instant message (FIGS. 7-9 and column 8, lines 55-60) [The ACP 125 query the database to get delivery instructions and delivers the voice

message to the user's instant messaging client if the user is on line, thereby determining if said recipient is available to receive an instant message]; and

converting the voice mail message to an email message if said recipient is not available to receive an instant message (FIGS. 7-9 and column 8, lines 60-63) [The ACP 125 deliver the voice message as an e-mail attachment if the user is not currently on line, thereby converting the voice mail message to an email message if said recipient is not available to receive an instant message].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Groner using the automated call processor as taught by Hanson.

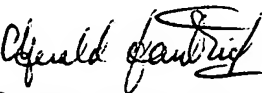
This modification of the invention enables the system to determine if said recipient is available to receive an instant message and converting the voice mail message to an email message if said recipient is not available to receive an instant message so that the user would receive a telephone call via its instant messaging client as a virtual second telephone line (Hanson: column 2, lines 1-6).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

Gerald Gauthier
Examiner
Art Unit 2645

g.g.
July 21, 2005